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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,121	02/04/2004	Jason Clay Pearson	71580/US02	4287
71466	7590	05/02/2008	EXAMINER	
LOUIS N. MORENO P.O. BOX 511, B-75 KINGSPORT, TN 37662			SZEKELY, PETER A	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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Mailed : *5-2-08*

In re Application of : DECISION
Pearson et al. : GRANTING
Serial No. 10/772,121 : PETITION
Filed: February 4, 2004 :
For: POLYMER BLENDS :
:

This is a decision on the March 28, 2008 "Petition under 37 CFR 1.181(a)."

Applicant filed an appeal brief on January 4, 2008, which was followed in due course by the examiner's answer mailed February 5, 2008.

The instant petition was then timely filed on March 28, 2008 and is before the Director of Technology Center 1700 for consideration. The petition requests that the examiner's answer of February 5, 2008 be deemed to contain a "new grounds of rejection."

Subsequent to the petition, a second examiner's answer was mailed on April 9, 2008. This answer appears to be substantially identical to the first answer. Accordingly applicant's petition will be treated as requesting that the April 9, 2008 be deemed to contain a new grounds of rejection also.

The petition is **GRANTED** for the reasons below.

DECISION

As background, new grounds of rejection are discussed in MPEP 1207.03:

A new prior art reference applied or cited for the first time in an examiner's answer generally will constitute a new ground of rejection. If the citation of a new prior art reference is necessary to support a rejection, it must be included in the statement of rejection, which would be considered to introduce a new ground of rejection. Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection. *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n. 3 (CCPA 1970). Where a newly cited reference is added

merely as evidence of the prior statement made by the examiner as to what is "well-known" in the art which was challenged for the first time in the appeal brief, the citation of the reference in the examiner's answer would not ordinarily constitute a new ground of rejection within the meaning of 37 CFR 41.39(a)(2).

In the instant application, the final rejection (mailed July 3, 2007) included a rejection under 35 USC 103(a) of the pending claims as being unpatentable over 24 references in a variety of permutations. The examiner's answer paired this down to a mere 8 references. In addition, two references were cited in the 'response to arguments' section, the Strand and Shih references. These references were not included in the statement of rejection, were not among the previously applied 24 references, were in fact not even previously of record.

As stated in MPEP 1207.03, any reference relied upon to support a rejection must be included in the statement of rejection. Thus Strand and Shih must be included in the examiner's statement of rejection. Further, reliance upon a new prior art reference generally constitutes a new ground of rejection, except where it is added merely as evidence of a prior statement made by the examiner as to what is "well-known" in the art which was challenged for the first time in the appeal brief. Such is not the case here, and therefore the inclusion of Strand and Shih constitutes a new grounds of rejection.

While 37 CFR 41.39(a)(2) permits the entry of a new ground of rejection in an examiner's answer mailed on or after September 13, 2004, any new ground of rejection made by an examiner in an answer must be approved by a Technology Center (TC) Director or designee, and prominently identified in the "Grounds of Rejection to be Reviewed on Appeal" section and the "Grounds of Rejection" section of the answer. Neither condition was met here, making the examiner's answer improper.

Further, MPEP 1207.02 states that 'If any rejection is withdrawn, the withdrawal should be clearly stated in the examiner's answer under subheading "Grounds of Rejection Withdrawn" in the section "Grounds of Rejection to be Reviewed on Appeal."'. In the instant case, the examiner has gone from applying 24 references in the final rejection to 8 (in fact 10) references in the answer. Thus the examiner's answer should also indicate that the previous grounds of rejection have been withdrawn and replaced in their entirety with the new grounds of rejection.

As the examiner's answer contains a new ground of rejection, such not having been identified in the answer nor approved by the Director's designee, the instant petition is GRANTED.

Accordingly, the examiner's answers of February 5, 2008 and April 9, 2008 are hereby vacated. Per MPEP 1207.03 (IV), the examiner is required to send a corrected examiner's answer that withdraws the previous rejections, identifies the new rejection as a new ground of rejection and includes the approval of the TC Director or designee.

In accordance with 37 CFR 41.39(b), applicant may thereafter file either a request that prosecution be reopened by filing a reply under 37 CFR 1.111, or a request that the appeal be maintained by filing a reply brief or resubmitting the previously-filed reply brief, within two months from the mailing of the corrected answer. The choice of whether to re-open prosecution or to maintain the appeal will thus be left to applicant's discretion.

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